

Remarks: Reconsideration of the application is respectfully requested. The examiner has objected to the drawings on the basis that several features are not depicted in the “elected diagrams.” However, such features are depicted in Figures 1 and 2 and such drawings were not canceled or deleted. Undersigned applicant has reviewed MPEP 608.02(d) and has found no requirement that the claimed features must be shown in an “elected” drawing. Applicant elected a species as defined by the claims.

Regarding the examiner’s 112 rejection of former claim 10, the claim correctly defines the subject matter. The slot is positioned beneath said lip when the bezel receives the neck to allow the clip to be positioned beneath the lip to prevent separation of the bezel and neck

New independent claim 11 includes the limitations of former claims 1 and 7. The examiner rejected claim 7 in light of Albanese and Hartman, “in further view of case law.” However, no case law was cited to support such rejections. Regardless, the examiner rejected the claim under 35 U.S.C. §103 because, inter alia, that Hartman teaches (the gear assembly as claimed). However, Hartman discloses a motorized ice cream cone, and in no way relates to jewelry.

To establish a prima facie case of obviousness, the examiner must establish, inter alia, that the references *teach or suggest* all claim limitations. M.P.E.P. § 2143.03. (Emphasis added) In applying 35 U.S.C. 103, the following factors should be considered:

- A) The claimed invention must be considered as a whole;
- B) The references must be considered as a whole and must suggest the *desirability* and thus the obviousness of making the combination;
- C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention, and;

D) Reasonable expectation of success is the standard with which obviousness is determined. M.P.E.P. § 2141, citing *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 (Fed. Cir. 1986).

A statement that modifications of the prior art were well within the ordinary skill of the art because the references cited teach that all of the features are individually known does not establish a prima facie case of obviousness *without some objective reason to combine the teachings of the references*. (Emphasis added). M.P.E.P. § 2143.01, citing *Ex Parte Levengood*, 28 U.S.P.Q. 2d 1300 (B.P.A. I. 1993). The fact that the prior art could be modified in a manner suggested by the examiner did not make modification obvious unless prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992).

Applicants' gear system and drive motor assembly required many years of design to achieve the proper torque and movement that could be produced on an item as minuscule as jewelry. The claimed gear assembly allows the gears and sprockets to be sized accordingly, while achieving the torque necessary to rotate stones weighing as much as 3.5 g. The relative weight being rotated by the quartz movement motor is much higher than that of conventional quartz movement applications, which is precisely the reason that jewelry having quartz movement motors for rotating a jewel stone do not exist in the prior art. Furthermore, the examiner has made no showing whatsoever how Hartman suggests adding its gear arrangement to a jewelry item to achieve the results of the present invention.

Not only is the claimed combination not disclosed or suggested in the prior art, the device in Hartman is a non-analogous art. For example, in *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), the applicant claimed an improvement in a hose clamp which differed from the prior art in the presence of a preassembly "hook" which maintained the preassembly

condition of the clamp and disengaged automatically when the clamp was tightened. The Board relied upon a reference which disclosed a hook and eye fastener for use in garments, reasoning that all hooking problems are analogous. The court held the reference was not within the field of applicant's endeavor, and was not reasonably pertinent to the particular problem with which the inventor was concerned because it had not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. MPEP §2141.01(a). Likewise, a jeweler looking to create jewelry having a quartz movement for slowly, smoothly and continuously rotating a gemstone, would not be expected or motivated to look to ice cream cone holders, particularly considering that implementing the gear assembly of Hartman would not function as does the claimed invention. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The prior art is devoid of any suggestion or teaching of the gear assembly in combination with a quartz movement motor and/or the jewelry stone.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The examiner has not presented a convincing line of reasoning as to why the applicant could readily combine an ice cream cone holder with a spring motor operated jewelry display to form the

claimed invention.

Original claims 1,2 and 4 directed toward the quartz movement motor were rejected under 35 U.S.C. 102(b) based on the patent to Marshall. The examiner noted that Marshall disclosed “a bezel (72) rotatably mounted on the upper end of said housing (via 24).” Element 72 is a ring holder, consisting of two leaves, that is received within an aperture 24. The device does not disclose or suggest a bezel. The Merriam-Webster online dictionary defines bezel as:

“1 : a rim that holds a transparent covering (as on a watch, clock, or headlight) or that is rotatable and has special markings (as on a watch)

2 : the oblique side or face of a cut gem; *specifically* : the upper faceted portion of a brilliant projecting from the setting.

3 : a usually metal rim of a piece of jewelry in which an ornament (as a gem) is set.”

No such item is remotely disclosed in Marshall.

The examiner further stated that Marshall disclosed “a motor means (14) received within said housing (14) [for automatically rotating said bezel and said gemstone at a predetermined, discrete speed]. Examiner’s note: the statement within brackets is an example of intended use, as the statement does not further limit the structure of the claimed invention. It only requires that the prior art have the capacity of performing such, and in the instant case, it does.”

The pertinent claim language is not intended use but instead a means plus function claim. The sixth paragraph 35 U.S.C. 112 states that a claim limitation expressed in means-plus-function language “shall be construed to cover the corresponding *structure* described in the specification and equivalents thereof.” (Emphasis added).


Though Marshall discloses a quartz movement motor, it does not suggest using a quartz motor for rotating a gemstone on a jewelry item. As stated above, the ability to do so before the invention of the claimed subject matter did not exist. Furthermore, the device is unrelated because it pertains to a rotating display, and not rotating a gemstone on a jewelry item. (See

discussion, supra).

The switch mechanism contained in former claim 5, now claim 16, is not remotely disclosed or described in Marshall. Marshall simply describes a depressible switch that is actuated by opening or closing a lid. Furthermore, the switch does not "carry" a battery, but instead connects thereto when in a raised position.

Finally, applicant is also claiming the integrated circuit which is not found in any of the references cited herein. For the foregoing reasons, applicant respectfully avers that the amended claims are allowable in light of the references cited herein.

Respectfully submitted,

  
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Kenneth L Tolar (Name of person making deposit)

 (Signature)

1. 17. 2006 (Date)